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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,528	08/29/2001	Takayuki Iida	Q64676	4729
7590 01/25/2007 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, NW Washington, DC 20037-3213			EXAMINER BURLESON, MICHAEL L	
			ART UNIT	PAPER NUMBER
			2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/940,528

Applicant(s)

IIDA, TAKAYUKI

Examiner

Michael Burleson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 22-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/27/2006 have been fully considered but they are not persuasive. Applicant states that the prior art reference of Moghadam US 5799219 fails to teach of an image reproduction section as claimed. Applicant points to the fact that Moghadam teaches the photographic printer (46) prints the digital file if the electronic address attached to the film strip is not sensed and that the electronic address is not used to determine whether some sort of an image data corresponding to the images on the film strip are available at the central computer (48) (see page 11 of Applicant's remarks). Examiner disagrees with Applicant. Moghadam teaches of producing photographic film with a magnetic data recording layer, which includes agency image server telecommunication address as well as other information (column 6, lines 28-48). This teaches that the magnetic data recording layer points to an image server and if this magnetic data is not sensed, photographic printer (46) will print a copy of the prints (column 5, lines 24-32). Rejection of claims 1-18 and 22-24 are maintained.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Claim Objections

2. Claim 27 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,2,5-8,11,16-18 and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Moghadam et al. US 5799219.

5. Regarding claim 1, Moghadam et al. teaches of an image server (central computer (48)) in which image data of an image formed on an image recording medium is stored (column 5,lines 8-10 and 21-24 and column 6,lines 11-19).

6. An image reading section (PIW (42)) for reading the image formed on the image recording medium (column 4,lines 65-67).

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7. An image information reading section (magnetic stripe reader) for reading, from the image recording medium, image information including information for specifying the image server and a position at which the image data is stored in the image server (column 5, lines 15-17 and column 6, lines 11-18 and lines 28-48).
8. An image data reading section (film processor) for reading the image data corresponding to the image information from the image server based on the image information read by the image information reading section (column 5, lines 15-29 and column 6, lines 11-18 and lines 28-48).
9. An image reproduction section (photographic printer (46)) for forming, on another image recording medium which is different from the image recording medium, the image formed on the image recording medium based on one of image data, read by the image reading section, of the image or the image data read by the image data reading section, wherein the image reproduction section forms the imaged based on image data corresponding to the image read by the image reading section only if the image data corresponding to the image information is not available from the image server (column 5, lines 15-32).
10. Regarding claim 2, Moghadam et al. teaches the image information reading section is provided so as to read the image information recorded as an invisible image on the image recording medium (column 4, lines 5-8).
11. Regarding claims 5 and 6, Moghadam et al. teaches the image information reading section is provided in an image reading device in which the image reading section is provided (column 5, lines 15-17).

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12. Regarding claims 7 and 8, Moghadam et al. teaches the image reading section is used as the image information reading section (column 5, lines 15-21).

13. Regarding claim 11, the structural elements of apparatus claim 1 performs all of the method steps of method claim 11. Thus, claim 11 is rejected for the same reasons discussed in the rejection of claim 1.

14. Regarding claims 16 and 17, Moghadam et al. teaches of an image processing unit (film processor (40)), wherein the image processing unit determines whether the image data corresponding to the image read by the image reading section or the image data read by the image data reading section is used (column 5, lines 15-30).

15. Regarding claim 18, Moghadam et al. teaches of determining whether the image data corresponding to the image read by the image reading section or the image data read by the image data reading section is used, prior to the reproducing (column 5, lines 15-30).

16. Regarding claim 23, Moghadam et al. teaches in a case in which the image information is read by the image information reading section and the image data corresponding to the image information is present at the image server (column 5, lines 8-10 and 21-24 and column 6, lines 11-19).

17. the image reproduction section forms the image on the other image recording medium on a basis of the image data read by the image data reading section from the image server (column 5, lines 15-28).

18. in a case in which the image data corresponding to the image information is not present at the image server, the image reproduction section forms the image on the

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other image recording medium on a basis of the image data of the image read by the image reading section (column 5, lines 15-28).

19. Regarding claim 24, Moghadam et al. teaches of an encode section which converts a URL information indicating a position at which the image data is stored (column 6, lines 10-20).

20. Regarding claim 25, Moghadam et al. teaches wherein the image processing unit determines whether the image data corresponding to the image information is not available from the image server to determine whether the image data corresponding to the image read by the image reading section or the image data read by the image data reading section is used (column 5, lines 15-30).

21. Regarding claim 26, Moghadam et al. teaches the step of reproducing includes determining whether the image data corresponding to the image information is not available from the image server to determine whether the image data corresponding to the image read by the image reading section or the image data read by the image data reading section is reproduced (column 5, lines 15-30).

22. Regarding claim 27, the structural elements of apparatus claim 1 performs all of the structural elements of system claim 27. Thus, claim 27 is rejected for the same reasons discussed in the rejection of claim 1.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 3,4,12,15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al. US 5799219 in view of Shih et al. US 6674923.

25. Regarding claims 3 and 4, Moghadam et al. teaches all of the limitations of claims 1 and 2.

26. Moghadam et al. fails to teach the image information reading section is provided so as to read the image information recorded as a bar code on the image recording medium.

27. Shih et al. teaches the image information reading section is provided so as to read the image information recorded as a bar code on the image recording medium (barcode 32 is read by reading section 105, column 4, line 11 and column 8, lines 43-44).

28. Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Moghadam et al. wherein Moghadam et al.'s printing system is able to record a barcode on the image reading medium. It would have been obvious to one of ordinary skill in the art at the time of the applicant's

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invention to modify Moghadam et al. by the teaching of Shih et al. in order to read URL in which the images are stored.

29. Regarding claim 12, the structural elements of apparatus claim 2 performs all of the method steps of method claim 12. Thus, claim 12 is rejected for the same reasons discussed in the rejection of claim 2.

30. Regarding claim 15, the structural elements of apparatus claim 3 performs all of the method steps of method claim 15. Thus, claim 15 is rejected for the same reasons discussed in the rejection of claim 3.

31. Regarding claim 22, Moghadam et al. teaches all of the limitations of claim 1.

32. Moghadam et al. fails to teach the image reading section reads two dimensionally the image from the image recording medium, which is stored in the server as image data.

33. Shih et al. teaches using a scanner in the system for scanning the image (column 4, lines 36-39, column 9, lines 55 and column 10, lines 8) and being able to store such an image at the server (column 9, lines 9), Shih et al. does not specifically teach the scanner to read two dimensionally.

34. However, Examiner takes Official Notice that well known prior art teaches scanners that scan both in the X direction (first dimension) and Y direction (second dimension) because images are almost always two dimensional.

35. It would have been obvious to one of ordinary skill in the art that the scanner of Shih et al could have scanned two dimensionally. The motivation for doing so would have been to be able to scan two-dimensional images.

36. Claims 9,10,13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al. US 5799219 in view of Bryniarski et al. US 6215559.

37. Regarding claims 9 and 10, Moghadam et al. teaches all of the limitations of claims 1 and 2, as well as, the image reading section and the image information reading section are provided so as to read the image and the image data, respectively, formed on a photographic photosensitive material used as the image recording medium (column 4,lines 65-67,column 5,lines 15-17 and column 6,lines 11-18)

38. Moghadam et al. fails to teach an image is formed on a photographic photosensitive material by the image reproduction section

39. Bryniarski teaches and an image is formed on a photographic photosensitive material by the image reproduction section (column 4,lines 49-50).

40. Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Moghadam et al. wherein Moghadam et al. printing system is able to print photographs on photosensitive material. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Moghadam et al. by the teaching of Bryniarski in order to print high quality prints without using ink and photosensitive material prints are generally sturdier than standard paper.

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41. Regarding claim 13, the structural elements of apparatus claim 9 performs all of the method steps of method claim 13. Thus, claim 13 is rejected for the same reasons discussed in the rejection of claim 9.

42. Regarding claim 14, Moghadam et al. teaches all of the limitations of claim 11 and the image carrier is a media for recording image data of an image photographed by a digital still camera (column 7, lines 5-14).

43. Moghadam et al. fails to teach an image recording medium is a photographic photosensitive material.

44. Bryniarski teaches an image recording medium is a photographic photosensitive material (column 4, lines 49-50).


45. Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Moghadam et al. wherein Moghadam et al. printing system is able to print photographs on photosensitive material. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Moghadam et al. by the teaching of Bryniarski in order to print high quality prints without using ink and photosensitive material prints are generally sturdier than standard paper.

Conclusion

46. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Burleson whose telephone number is 571-272-7460. The examiner can normally be reached Monday through Friday from 8:30 A.M. to 5:00 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tywler Lamb can be reached on 571-272-7406.


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER

Michael Burleson
Patent Examiner



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MIb
January 20, 2007